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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,806	02/18/2004	Jacob Zabara	200477.00002	1496

21324 7590 12/31/2007  
HAHN LOESER & PARKS, LLP  
One GOJO Plaza  
Suite 300  
AKRON, OH 44311-1076

EXAMINER
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GILBERT, SAMUEL G

ART UNIT	PAPER NUMBER
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3735

NOTIFICATION DATE	DELIVERY MODE
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12/31/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@hahnlaw.com  
akron-docket@hotmail.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/780,806	<b>Applicant(s)</b> ZABARA, JACOB	
	<b>Examiner</b> Samuel G. Gilbert	<b>Art Unit</b> 3735	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-78 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-26 is/are allowed.
- 6) ☒ Claim(s) 27-30, 32-35, 37-41, 43-48, 50-53, 55-62, 64, 65, 67-71 and 73-78 is/are rejected.
- 7) ☒ Claim(s) 31, 36, 42, 49, 54, 63, 66 and 72 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 73-75 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims include placing material in the brain which positively set forth a combination with the human body which is nonstatutory subject matter. The applicant should consider “adapted to” language.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 27-30, 32-35, 37-41, 43-48, 50-53, 55-62, 64-65, 67-71, and 76-78 are rejected under 35 U.S.C. 102(b) as being anticipated by Cadwell (4,940,453).

Claim 27-30 - Cadwell teaches applying magnetic and electrical stimulation to the brain independent of unwanted neural activity. The magnetic field is pulsed, alternating and steady.

Claims 32-35 - current is produced as claimed and no seizures are produced.

Claims 37 - seizures are not produced in using Cadwell.

Claims 38-40 - the structure is provided as set forth below.

Claim 41 - one coil is selectively oriented.

Claims 43-48 - the effects claimed are inherently present in the stimulation applied by Cadwell.

Claims 50, 56-58, 62, 64, 65, 67, 68, 69, 70, 76-78 - element -32- is a magnetic stimulation subsystem, element -37- is an electric stimulation subsystem, and -29- is a computer based switching subsystem. The therapeutic pulses are generated independently of unwanted neural activity. Many of the claims recite functional limitations or method step limitations which do not further limit the structure required by the claims. The device of Cadwell is capable of performing the recited functional/method step limitations.

Claim 51 - element -32- includes capacitors, an energy source and a coil -31-.

Claim 52 - the system is capable of stimulating the vagus nerve.

Claim 53 - evoked potentials are measured.

Claim 55 - element -29- is a controller.

Claim 59 - element -31- is a coil.

Claim 60 - temperature sensors are used to limit the temperature of the coil,  
column 11 lines 38-48.

Claim 61 - elements -33a- and -33b- is considered a high power cable.

Claim 71 - a transformer is set forth in the coil power supply.

***Allowable Subject Matter***

Claims 1-26 are allowed.

Claims 31, 36, 42, 49, 54, 63, 66, and 72 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel G. Gilbert whose telephone number is 571-272-4725. The examiner can normally be reached on Monday-Friday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor II can be reached on 571-272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3735

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Samuel G. Gilbert/  
Primary Examiner, Art Unit 3735

Samuel G. Gilbert  
Primary Examiner  
Art Unit 3735